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|--|-------------|----------------------|---------------------|------------------|
| 10/577,855 | 04/28/2006 | David William Taylor | 127865 | 4856 |
| 25944 7590 08/13/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER | | | | |
| BHAT, ADITYA S | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,855

Applicant(s)

TAYLOR, DAVID WILLIAM

Examiner

ADITYA S. BHAT

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/IS/C)
Paper No(s)/Mail Date 4/28/06 8/24/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status

1. Claims 1-10 are currently pending in this application. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by McMurtry US PUB # 2006/0037208.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

3. Claims 1-10 are objected to because of the following informalities: The claims contain reference numeral(s) which is not in accordance with normal US practice. Appropriate correction is required.

Specification

4. The disclosure is objected to because of the following informalities: The specification is missing sections or the titles to the sections as provided in 37 CFR 1.77(b),

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A

COMPACT DISC.

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Appropriate correction is required.

Information Disclosure Statement

5. The information disclosure statement's (IDS) submitted on 7/24/2006 & 4/28/2006 have been received. The submission is in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement has been considered by the examiner.

Drawings

6. The drawings submitted on 4/28/2006 are in compliance with 37 CFR § 1.81 and 37 CFR § 1.83 and have been accepted by the examiner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by
McMurtry US PUB # 2006/0037208

With regards to claim 1, McMurtry US PUB # 2006/0037208 teaches a method of scanning comprising the steps of:

providing a scanning system having a sample holder and a relatively movable scanning device ;(see figure 1)

performing a scan of at least a part of an object located on the sample holder;
(200; figure 2)

establishing orientation of a plane of the sample holder; (page 2. paragraph 0032) and

interpreting data from the scan using the orientation of the sample holder characterised in that, the orientation is established using data from the scan of the object. (page 2. paragraph 0036)

With regards to claim 2, McMurtry US PUB # 2006/0037208 teaches the orientation is established by defining a plane of the sample holder. (Page 2. paragraph 0032)

With regards to claim 3, McMurtry US PUB # 2006/0037208 teaches the plane in which orientation is established is limited by boundaries. (limits of motion; page 2. paragraph 0038)

With regards to claim 4, McMurtry US PUB # 2006/0037208 teaches the orientation is established by extracting at least three measurements. (Page 2. paragraph 0042)

With regards to claim 5, McMurtry US PUB # 2006/0037208 teaches the orientation is established by extracting data for **at least** 240 degrees around the surface of the sample holder. (Page 2. paragraph 0040) measures in a circular direction (360 degrees)

If applicant believes that measuring 240 degrees to be novel applicant should explain why this specific angular measurement would provide unexpected results or why this specific angle is novel in view of the prior art.

With regards to claim 6, McMurtry US PUB # 2006/0037208 teaches the orientation is established by measuring during a single process. (600,700; figure 2)

With regards to claim 7, McMurtry US PUB # 2006/0037208 teaches the orientation is established by measuring during more than one discrete processes. (600,800; figure 2)

With regards to claim 8, McMurtry US PUB # 2006/0037208 teaches the orientation is established within a defined vertical envelope with respect to the sample holder. (Page 2. paragraph 0025)

With regards to claim 9, McMurtry US PUB # 2006/0037208 teaches a method of scanning comprising the steps of:

providing a scanning system having a sample holder (page 2. paragraph 0026)
and

a relatively movable scanning device; (page 2. paragraph 0025)
scanning a datum; (figure 2)
scanning a sample; and interpreting data from the sample scan using data from the datum scan; (page 2, paragraph 0032)
characterised in that the scanning system automatically carries out the datum and sample scans. (page 1, paragraph 0011)

With regards to claim 10, McMurtry US PUB # 2006/0037208 teaches a method of scanning comprising the steps of:

providing a scanning system having a sample holder and a relatively movable scanning device (page 2. paragraph 0025-0026);

scanning a datum; (figure 2)

scanning a sample; and interpreting data from the sample scan using data from the datum scan; (page 2. paragraph 0032)

characterised in that both the datum and sample scans are carried out effectively as one scan. (figure 2)

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seddon et al. (USPN 6327788) teaches surface form measurement.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADITYA S. BHAT whose telephone number is (571)272-2270. The examiner can normally be reached on M-F 9-5:30.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aditya Bhat/
Examiner, Art Unit 2863
August 12, 2008